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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,727	02/12/2002	Stephan Erich Hills Strebl	STREBL- MOBILE	6716

7590 09/26/2003

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EXAMINER	
SUHOL, DMITRY	

ART UNIT	PAPER NUMBER
3712	8

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/074,727	HILLS STREBL ET AL.	
	Examiner	Art Unit	
	Dmitry Suhol	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 7-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 7-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 7-8, the limitations encompassed by "means adapted to reproduce said pattern of audible sounds from said media" and "adapted to reproduce said pattern of audible sounds only" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to disclose any sort of reproduction of any audible sounds.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 7 and 8, the features encompassed by "means adapted for replacing any of said means for providing an audio program" are not clear. It is not understood what structural features applicant is claiming (i.e. an ejection button on a tape player or a human hand that changes a CD or a tape or something else?). Applicants appear to describe a replacement audio program, however, only a means for replacement of an audio program is currently claimed. Overall, it is unclear what structural limitations the applicants are attempting to claim. Furthermore, it is unclear what features are encompassed by the phrase "means adapted to reproduce said pattern of audible sounds from said media". It is not clear what features "reproduce" the audible sounds.

Regarding claim 8, the features encompassed by "means for replacing any of said plurality of display objects with a replacement display object" are not clear. It is not understood what structural features applicant is claiming (i.e. a connection between an object and a mobile arm, or an container housing additional objects or something else?).

The remainder of the action considers the claims as best understood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fearon et al '360 in view of Reynolds et al '098. Fearon discloses a synchronized infant mobile which rotates in response to audible characteristics (col. 3, lines 5-7) containing most of the elements of the claims including, at least one object (elements 50) as required by claims 1, 3 and 9, a means for supporting at least one object (figure 1) as required by claims 1 and 3, a means for presenting an object to an infant in a continuous and automatic circular motion, as required by claims 1, 3-5 and 9, (motor 30) where it is considered that motor 30 provides and desired level of circular continuity depending on the sounds generated by audio system 85 or 100, a means for providing an audio program (col. 2, lines 36-41) as required by claims 1, 3 and 9, a plurality of distinct objects (fig. 1, elements 50) as required by claim 2, an audible sound including an audible reference (col. 2, lines 36-41) as required by claims 2-3 and 5, a means adapted for changing a plurality of objects (fig. 1, elements 55) as required by claim 6. A means for replacing any means for providing an audio program with a replacement audio program is considered to be inherent in that any tape player or CD player would have an eject button to remove and replace a CD/tape.

Fearon lacks the teaching of an audio program including an audible reference that identifies the object. However, Reynolds teaches a mobile which synchronizes

audible sounds with predetermined distinct collectibles/objects (col. 2, lines 30-34). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to incorporate the teachings of Reynolds in the device of Fearon by incorporating audible reference to an object for the purpose of adding entertainment value to the device of Fearon.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fearon et al '360 in view of Baik. Fearon discloses a synchronized infant mobile which rotates in response to audible characteristics (col. 3, lines 5-7) containing most of the elements of the claims, as stated above, but for an audio program including an audible reference to an object. However, Baik teaches a mobile which synchronizes audible sounds with predetermined objects (page 3, paragraph [0013]). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to incorporate the teachings of Baik in the device of Fearon by incorporating audible reference to an object for the purpose of adding entertainment value to the device of Fearon.

Response to Arguments

Applicant's arguments filed 22 July 2003 have been fully considered but they are not persuasive. Applicants argue that Baik teaches away from "rotating elements" at the end of paragraph 0013. In response the examiner points out that Baik is relied upon to teach an audible program synchronized with predetermined objects and not the concept

of rotating elements, however the examiner does wish to point out that applicants appear to misinterpret Baik. The line that applicants appear to point to in the Baik reference simply states that his invention provides more stimulation than the ordinary rotating ornament. Baik **does not** point to any pit falls of an automated mobile.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Fearon clearly discloses a mobile where one of the primary objectives is entertainment (see Fearon col. 2, lines 60-62). Reynolds and Baik clearly add to the entertainment concept and clearly state so (see Reynolds col. 5, lines 45-46 and Baik page 3, first line in paragraph 0011). Therefore it is clear that the combination of Fearon and Reynolds or Fearon and Baik is obvious for the purpose of entertainment to the user (as pointed to by all three references).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700